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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/905,329	07/13/2001	Jonathan David Goodwin	41543/RRT/S850	6970
23363 7590 07/20/2007 CHRISTIE, PARKER & HALE, LLP PO BOX 7068 PASADENA, CA 91109-7068			EXAMINER BORISSOV, IGOR N	
			ART UNIT 3628	PAPER NUMBER
			MAIL DATE 07/20/2007	DELIVERY MODE PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 09/905,329	Applicant(s) GOODWIN ET AL.	
	Examiner Igor N. Borissov	Art Unit 3628	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 14 May 2007.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,3-5 and 7-68 is/are pending in the application.
- 4a) Of the above claim(s) 23-68 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1,3-5 and 7-22 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Response to Amendment

Amendment received on 05/14/2007 is acknowledged and entered. Claims 2 and 6 have previously been canceled. Claims 23-68 have been withdrawn. Claims 1, 3, 4, 7, 10-11, 15, 16, 19-25, 31-33, 36-38 have been amended. Claims 1, 3-5 and 7-68 are currently pending in the application.

Examiner's Note

Applicant amended claims 23-42, which have been withdrawn from consideration (see last Office action of 11/17/2006).

37 CFR § 1.121(c) states: "if a withdrawn claim is currently amended, its status in the claim listing may be identified as "withdrawn-currently amended"".

Accordingly, Applicant is advised to provide proper claim identifiers for claims 23-42.

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claim 7 is rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. Claim 7 recites: "wherein the delivery confirmation service includes a pointer to a USPS form", which is not supported by Specification.

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The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1, 3-5 and 7-22 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 1 refers to an apparatus, and recites the following limitations: "GUI for providing certified mail service based on type of a mail piece selected by the user, wherein the GUI for providing certified mail includes business rules for providing the user with a return receipt", which is confusing. It is not clear to what extent a GUI represents a structural element. Furthermore, the claim is written in means plus function format, which is confusing. It is not clear how a GUI can provide for "certified mail service" or "providing a return receipt". Furthermore, said limitations of "providing certified mail service" or "providing a return receipt" indicates the intended use of the system, not a structural element.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1, 3-5, 7, 8, 11-15 and 20-22 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kara (US 6,233,568).

Claim 1. Kara teaches a web-enabled system for printing postage on a mail piece comprising:

a web-enabled client subsystem (Fig. 1A; C. 11, L. 29-31; C. 17, L. 52) for interfacing with a user, comprising:

a display comprising a graphical user interface (GUI) for installing software for printing the postage (Fig. 2);

a GUI for providing certified mail service based on type of a mail piece selected by the user, wherein the GUI for providing certified mail includes business rules for providing the user with a return receipt (Figs. 4A-4O; C. 21, L. 60-67; C. 3, L. 15; suggests return receipt feature; flow diagrams of Figs. 2, 5A-5B, 7, 10A-10F, indicates "rules" feature);

a server subsystem capable of communicating with the client subsystem over the Internet for authorizing the client subsystem to print the postage (C. 7, L. 47 – C. 8, L. 9).

Kara does not specifically teach providing insurance service based on type of a mail piece selected by the user.

However, Kara teaches providing user with ability to select a mail piece, and providing insurance service among other services (Figs. 4A-4O; C. 5, L. 63).

Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Kara to include providing insurance service based on type of a mail piece selected by the user, as suggested in Kara, because it would advantageously allow to provide a system which may be managed by a single service provider for providing various services, as specifically stated in Kara (C. 4. L. 15-19).

Claims 3, 4, 5, 7, 11, 15 and 20-22, see reasoning applied to claim 1.

Claim 8. Kara teaches that the client subsystem further comprises a GUI for specifying an address book from a plurality of address (C. 19, L. 55-62).

Claims 12-14, the use of the Internet suggests browsing the Web including on-line shopping.

Claims 9 and 10 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kara in view of Moore (US 5,452,203).

Claim 9. Kara teaches all the limitations of claim 9, except that the client subsystem further comprises an address matching module for verifying an address entered by the user.

Moore teaches an apparatus for correcting customer address lists, wherein said apparatus is configured to implement a mailing address list cleansing routine via matching (comparing) technique (C. 3, L. 50 – C. 5, L. 53).

It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Kara to include that the client subsystem further comprises an address matching module for verifying an address entered by the user, as disclosed in Moore, because it would advantageously allow to avoid undelivered mail.

Claim 10. Moore teaches overriding an incorrect address by returning to the user a valid address information (C. 3, L. 50 – C. 5, L. 53).

Claims 16-19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kara in view of Ryan, Jr. et al. (US 5,871,288).

Claims 16-18. Kara teaches all the limitations of claims 16-18, except that said GUI includes a first GUI for printing a quality assurance postage indicia.

Ryan, Jr. et al. (Ryan) teaches a system for generating and printing information based indicia in postage metering system, wherein a test print is conducted and inspected for errors, at which point a user can either accept the print, or reject it (C. 3, L. 28).

It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Kara to include that said GUI includes a first GUI for printing quality assurance postage indicia, as disclosed in Ryan, because it would advantageously allow to avoid printing wrong information, thereby save funds.

Claim 19. Ryan teaches said system, wherein the GUI for managing the printing comprises of a GUI for troubleshooting selected printing options (C. 3, L. 52-63).

Response to Arguments

Applicant's arguments filed 05/14/2007 have been fully considered but they are not persuasive.

In response to applicant's argument that the prior art fails to disclose a GUI for providing certified mail service with a return receipt, it is noted that Kara specifically teaches this feature (See: C. 21, L. 60-67; C. 3, L. 15).

In response to applicant's argument that the prior art fails to disclose business rules for providing said functionalities, it is noted that Kara teaches a computer implemented method, wherein all steps are implemented by a computer, and wherein said steps are governed by logic, thereby indicating said "business rule" feature (See: flow diagrams of Figs. 2, 5A-5B, 7, 10A-10F).

In response to applicant's argument that the prior art fails to disclose an address matching module having a user option overriding an incorrect address by returning to the user a valid address information, it is noted that Moore was applied to this feature (See: C. 3, L. 50 – C. 5, L. 53).

Conclusion

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within

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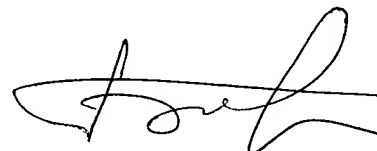
TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure (see form PTO-892).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Igor Borissov whose telephone number is 571-272-6801. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John W. Hayes can be reached on 571-272-6708. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

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07/17/2007



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